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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,206	03/17/1999	JOSEPH C. KAWAN	CIIT10096	3773

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EXAMINER

TAYLOR, LARRY D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/271,206

Applicant(s)KAWAN, JOSEPH C. **Examiner**

Larry D Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt of Amendment

1. Receipt is acknowledged of the amendment filed 08 November 2002.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-12, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitahara (US 5,821,515, of record) in view of Furuhashi et al. (US 6,029,887, of record) and Taylor (US 5,530,232, of record and cited by applicant).

Kitahara teaches a method and device for reading and writing to a multi-memory card, in specific, positioning a first memory 1A of a card within a first read/write component 29 to be read from or written to and positioning a second memory 1B of the card within a second read/write component 48 to be read from or written to (see figures 1 and 2). The first memory 1A is an optical memory area, wherein transport motor device 12 conveys the card into a first position to be read by read/write head 29. The second memory 1B is an electrical IC chip, wherein, after the memory 1A is read, motor 12 transports the card into a second position. Solenoid 51 is used by controller 54 to engage read/write head 48 with the memory 1B (figures 3 and 4). Position sensors 36 and 37 detect the position of the card for reading/writing. It is taught

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that a central control circuit (Central Processor Unit) drives the motor and components (col. 5, lines 19-25 and lines 63-65).

It is not specified, however, the card having a third memory, the device employing a third read/write component for reading said memory.

Furuhashi teaches a transaction card 1 containing IC (first) memory 11, optical (second) memory 13, and magnetic (third) memory 14 (see figure 1 and col. 11, lines 53-64). During use by a cardholder, the card's memories are read and written to by interface between the holder and a payee entry device. The device contains a display 143, input means 141, and an apparatus 145 for reading and writing to the memory(s) of the card (figures 13 and 14).

It would have been obvious to one of ordinary skill in the art to provide a third means of memory in addition to the first and second memory of the card of Kitahara, as it would inherently add more memory space upon the card and provide greater options and versatility to the holder of the card. It would allow the user to obtain and access a greater number of accounts and/or account data, use the card at greater plurality of reader terminals, etc. Kitahara states that the card may also employ a magnetic memory area, in which a read/write head would be present in place of the optical head 29 (see Kitahara, col. 10, lines 5-11). This depicts that the device of Kitahara may also contain mechanical means of reading/writing to the magnetic stripe on the card. With the teachings of Furuhashi, it would have been an obvious expedient to one of ordinary skill to add such means to facilitate the reading and writing of data to all three types of memories that would be available on the card.

Kitahara fails to detail the method of reading the card as being in a financial capacity, specifically providing selectable functions to the cardholding user between readings/writings of

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the memory areas, the functions affecting an account held by the user, and displaying results of the selected functions.

Taylor teaches a data card that holds both an IC chip and magnetic stripe (see figure 2). Once the card is placed within a terminal and the chip or magnetic stripe is read, the user is presented with many selectable functions and records, including selecting card applications, reviewing or updating account information, or paying a vendor (figure 4 and col. 5, line 25 – col. 6, line 48). Input and output means are communicated through keypad and display area 24.

It would have been obvious to one of ordinary skill in the art to provide such selectable options of Taylor between the readings of the memories of Kitahara. It is well known in the art to provide a cardholder with options at a reader terminal pertaining to the data of his/her account(s). Automated teller machines provide selectable functions to a user when accessing funds. Such a feature presented by Taylor allows the user to dictate the readings of the card, to specifically customize the reading to/writing from of the data within the card. To the user, the card will be more personalized and with specific options given to the user, the time spent performing transactions would be significantly less. In another sense, it is known for multi-memory card readers to have all the different read/write components within in small area. Providing the different read/write heads at distances such that the card must traverse allows the heads to be services individually, should one particular head malfunction. This prevents an entire read/write head module from having to be replaced in such a manner that would be costly and cumbersome. Please note that the teachings of Furuhashi also teach the memories of the card as being readable or writeable as a result of functions selected at an input device by a user.

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4. Claims 13 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitahara as modified by Furuhashi et al., and further in view of Barakat (US 4,910,774).

The teachings of Kitahara as modified by Furuhashi have been discussed above. However, the teachings fail to show the control device as generating a key at the electronic memory for encrypting writing on the optical memory.

Barakat teaches a memory card that uses at least 3 memory areas (one area including electrical memory), whereas when the card is initialized, a device generates a key within a first memory of the card, the key encrypting data written to a second memory of the card (see figure 1, abstract, and col. 4, line 65 – col. 5, line 26).

While Barakat does not specifically teach the use of magnetic and optical memory in addition to the electrical memory, it would have been obvious to one of ordinary skill in the art to provide the concept of generating a key in a first memory area to encrypt a second memory as such an expedience adds security to the data within the card. Generating the key in the first (electrical) memory allows the algorithm for obtaining data to be specific to the card. If a predetermined key were assigned to a plurality of keys, a thief could steal one key of data on one card and compromise data from the rest of the plurality. With the key generated by the first memory of the specific card, the data of the second (optical) memory area would be more secure to fraudulent users.

Response to Arguments

5. Applicant's arguments in response to the previous Office Action's rejection of claims 1-3, 5-12, and 23 have been fully considered but they are not persuasive.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Kitahara teaches a method and device for reading and writing to a multi-memory card, the card having two memories.

Furuhashi teaches a multi-memory card for transaction use, the card having a first, second, and third memory. Adding a third memory to the card of Kithara provides extra memory space as well as versatility to a large number of card reading devices. Taylor teaches a user selectable menu for accessing options, records, and applications of memories of a transaction cards. Note that Furuhashi also teaches the memories of the card as being readable or writeable as a result of functions selected at an input device by a user.

7. Applicant's arguments with respect to claims 13 and 15-22 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner provides the teachings of Barakat, which show a multi-memory card with a security data key generated on one memory area to be used for encrypting data to another memory area. Such a concept is well known in the art and would have been obvious to employ (see rejection above).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D Taylor whose telephone number is (703) 306-5867. The examiner can normally be reached on M-F (8:30 - 5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703)-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-746-4784 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Larry D Taylor
December 30, 2002



KARL D. FRECH
PRIMARY EXAMINER